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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,654	06/04/2001	Zoltan Kiss	U11.12-0146	4266

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EXAMINER

MELLER, MICHAEL V

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/873,654

### Applicant(s)

KISS, ZOLTAN

### Examiner

Michael V. Meller

### Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-10 and 29-31 is/are pending in the application.
- 4a) Of the above claim(s) 3,5,6,10,29 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,7-9,27 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 3, 5, 6, 10, 29 and 30 remain withdrawn from further consideration by the examiner as being drawn to non-elected subject matter.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by SU 1138410.

The reference teaches that placental alkaline phosphatase and gel are together. Such a composition can be used topically.

### ***Claim Rejections - 35 USC § 103***

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Claims 1, 7-9, 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over SU 1814764 in view of Sugitachi et al., Fisher et al., or DE 3007226 and further in view of JP 60117919 and Millan et al.

SU teaches that alkaline phosphatase is used to treat wounds and includes the use of a gel, see abstract.

Sugitachi et al. (claims), Fisher et al. (claims), or DE 3007226 (abstract) teach that gelatin is known to be used in wound healing.

JP teaches that placental alkaline phosphatase is a highly desirable enzyme to use.

Millan teaches that placental alkaline phosphatase is a well known alkaline phosphatase to use and is highly desirable.

It is well known that it is *prima facie* obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose. The idea for combining them flows logically from their having been used individually in the prior art. *In re Sussman*, 1943 C.D. 518; *In re Pinten*, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); *In re Susi*, 58 CCPA 1074, 1079-80; 440 F.2d 442, 445; 169 USPQ 423, 426 (1971); *In re Crockett*, 47 CCPA 1018, 1020-21; 279 F.2d 274, 276-277; 126 USPQ 186, 188 (1960).

The reason or motivation to modify a reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. While there must be motivation to make the claimed invention, there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention.

MPEP 2144 Sources of Rationale Supporting a Rejection Under 35 U.S.C. 103.  
<[http://www.uspto.gov/web/offices/pac/mpep/documents/2100\\_2144.htm](http://www.uspto.gov/web/offices/pac/mpep/documents/2100_2144.htm)>

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The references all use the individual ingredients for the same purpose namely to promote wound healing. Millan and JP establish that it is merely the choice of the artisan which alkaline phosphatase they use to optimize the desired results.

Claims 1, 4, 7-9, 27, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over SU 1814764 in view of Sugitachi et al., Fisher et al., or DE 3007226 and further in view of JP 60117919 and Millan et al. and still further in view of WO 92/14480.

The teachings of the references are above. WO teaches that insulin is known to be used to topically treat wounds, see especially page 13.

Thus it also would have been obvious to also use insulin in the composition since insulin is also known in the art individually to be used to treat wounds as the other ingredients are as taught above.

Claims 1, 4, 7-9, 27, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugitachi et al., Fischer et al. or DE 3007226 taken with WO 92/14480 and Poelstra et al. and further in view of Millan et al.

Applicant has argued that the references do not teach the claimed invention. Fact is, they do. Gelatin has been shown to be known to be used to topically treat wounds. Insulin has been shown to treat wounds too. In fact, alkaline phosphatase has also been shown to treat wounds. Thus, since the individual components are known to be used individually for the same purpose, it would have been obvious to use them for the same

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purpose in a single combined composition. Applicants points out that Poelstra states that the enzyme (alkaline phosphatase) is applied at the site of the wound. This is what the examiner has been saying all along. Whether the site is at the bone or not, the enzyme is still being applied to the wound, thus topically. Millan establishes that the placental alkaline phosphatase is well known and it would have been merely the choice of the artisan in an effort to optimize the results to use such a well known enzyme to treat wounds.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael V. Meller whose telephone number is 571-272-0967. The examiner can normally be reached on Monday thru Friday: 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael V. Meller  
Primary Examiner  
Art Unit 1654

MVM